APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,305	02/13/2002	Karen Papierniak	9686 (3225-133)	4450

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EXAMINER
NGUYEN BA, HOANG VU A

ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

R&Q

	Application No.	Applicant(s)
Office Action Summary	10/073,305	PAPIERNIAK ET AL.
	Examiner	Art Unit	
	Hoang-Vu A Nguyen-Ba	2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _13 February 2002_.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-21_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1-21_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on _13 February 2002_ is/are: a)☐ accepted or b)☒ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
       1.☐ Certified copies of the priority documents have been received.
       2.☐ Certified copies of the priority documents have been received in Application No. _____.
       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the application filed February 13, 2002.

2.   Claims 1-21 have been examined.

Priority

3.   The priority date considered for this application is February 13, 2002.

Oath/Declaration

4.   The oath or declaration is defective. A new oath or declaration in compliance
with 37 CFR 1.63 identifying this application by application number and filing date is
required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

     a.   it does not identify the citizenship of inventor Giai DO of San
Diego, CA;

     b.   it does not state that the acknowledgment of the duty to disclose
information which is material to the examination of this application is in accordance
with 37 CFR **1.56** instead of 37 CFR 1.56(a).

Drawings

5.   This application has been filed with informal drawings (see Figures 4 and 5)
which are acceptable for examination purposes only. Formal drawings will be
required when the application is allowed.

Specification

6.   The title of the invention is not descriptive. A new tittle is required that

is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "Method and System for automating graph generation from data sets."

7.   The specification is objected to because of the following minor informality:

The use of trademarks, such as Visual Insights Advisor™, SPSS nVIZn SDK, etc. has been noted in this application. Trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

To expedite correction on this matter, the examiner suggests the following guidelines for Applicant to follow in amending the specification:

i.   Capitalize each letter of a trademark or accompany the trademark with an appropriate designation symbol, e.g., ™ or ®, as appropriate.

ii.   Use each trademark as an adjective modifying a descriptive noun. For example, it would be appropriate to recite "the JAVA platform" or "the JAVA programming language." Note that in these examples, "platform" and "programming language" provide accompanying generic terminology, describing the context in which the trademark is used. By itself, the trademark JAVA specifies only the source of the so-labeled products, namely SUN Microsystems, Inc.

Claim Rejections - 35 USC § 112

8.   The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to

enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9.   Claims 6 and 21 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 6 and 21 recite the limitation "transmitting the graph in connection with email." This limitation was nowhere described in the specification.

Claim Rejections - 35 USC § 101

10.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11.   Claims 13-21 are rejected under 35 U.S.C § 101 because the claimed invention is directed to non-statutory subject matter. ·

Pursuant to these claims, the term "system" is interpreted in light of the specification which describes that the system includes a database storing a data set, at least one rule, and at least one graph type and a graph generator (see section [010]). The same system is claimed in claim 13. The system's components recited in the claim, such as the database and the graph generator are merely software components, i.e., computer programs per se. Such claimed matter, which is descriptive material *per se*, non-functional descriptive material is not statutory because it is not a physical "thing" nor a statutory process as there are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships

between the computer program and other claimed aspects of the invention which

permit the computer's program's functionality to be realized. Since a computer

program is merely a set of instructions capable of being executed by a computer, the

program itself is not a process, without the computer-readable medium needed to

realize the computer's functionality. In contrast, a claimed computer-readable

medium encoded with a computer program defines structural and functional

interrelationships between the computer program and the medium which permit the

computer program's functionality to be realized, and is thus mandatory. *Warmerdam*,

33 F.d at 1361, 31 USPQ 2d at 1760. *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ

132, 137 (CCPA 1978). See MPEP § 2106 (IV)(B)(1)(a).

On this basis, claim 13 is rejected under 35 U.S.C. § 101.

Claims 14-21, which depend from claim 13, are also rejected under 35 U.S.C. §

101 for the same reasons.

Claim Rejections – 35 U.S.C. § 102

12.   The following is a quotation of the appropriate paragraphs of 35 U.S.C.

§ 102 that form the basis for the rejections under this section made in this Office

action:

A person shall be entitled to a patent unless –

(e) the invention was described in
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent,
except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

13.   Claims 1-4 and 7-20 are rejected under 35 U.S.C. § 102(e) as being anticipated
by U.S. Patent No. 6,477,538 to Yaginuma et al. ("Yaginuma").

Claim 1

Yaginuma discloses at least:

 selecting a data set (see at least Figures 1, 30, 31, 32, 33 and related
discussion in the specification);

 applying a rule to the data set (see at least Figures 1, 30, 31, 32, 33 and
related discussion in the specification); and

 generating at least one graph based on the data set and rule applied (see at least
Figures 1, 30, 31, 32, 33 and related discussion in the specification).

Claim 13

Yaginuma discloses at least:

 a database storing a data set, at least one rule, and at least one graph type (see at
least Figures 1, 18, 19 and related discussion in the specification); and

 *a graph generator selectively applying at least one rule and graph type to the data set to
generate at least one graph* (see at least Figures 1, 30, 31, 32, 33 and related discussion in
the specification).

Claims 2 and 20

Rejections of base claims 1 and 13, respectively are incorporated. Yaginuma
further discloses *selectively publishing at least one of the graphs generated* (see at least 16:35-
45).

Claims 7 and 21

Rejections of [base claim 1 and intervening claim 2] and 13, respectively are incorporated. Yaginuma further discloses *wherein the publishing step includes publishing a graph by storing the graph to a storage device* (see at least Figures 1, 18, 19 and related discussion in the specification).

Claims 3 and 18

Rejections of base claims 1 and 13, respectively are incorporated. Yaginuma further discloses *the step of customizing a rule* (see at least 15:13-38; Figures 14, 34-36 and related discussion in the specification).

Claims 4 and 19

Rejections of base claims 1 and 13, respectively are incorporated. Yaginuma further discloses *the step of customizing a graph type* (see at least Figures 14, 28-30, 34-36 and related discussion in the specification).

Claims 12 and 15

Rejections of [base claim 1 and intervening claim 4] and 13, respectively are incorporated. Claims 12 and 15 further disclose *wherein the graph type includes at least one of* a group of graph types consisting of *a pie chart, a bar chart, a tree graph, a spreadsheet chart, a scatter plot, and a 3-D graph*. Since claims 12 and 15 recite limitations in a form of alternative expression and explicitly claim at least one of the recited limitations, the Office considers only the limitation *tree graph* for art rejection purposes. The tree graph type is considered taught by Yaginuma (see at least Figure 39 and related discussion in the specification).

Claim 8

Rejection of base claim 1 is incorporated. Yaginuma further discloses *wherein the generating step occurs as a result of a trigger event* (see at least Figure 30 and related discussion in the specification).

Claim 9

Rejection of base claim 1 is incorporated. Yaginuma further discloses *wherein the generating step occurs as a result of a threshold being met or exceeded* (see at least 18:39-56).

Claims 10 and 14

Rejections of base claims 1 and 13, respectively are incorporated. further discloses *wherein the data set includes at least one of data, metadata, OLAP cubes, dimensional tables, lookup tables, and summary tables*. Since claims 10 and 14 recite limitations in a form of alternative expression and explicitly claim at least one of the recited limitations, the Office considers only the limitation *summary tables* for art rejection purposes. The limitation *summary table* is considered taught by Yaginuma (see at least Figure 39 and related discussion in the specification).

Claim 11

Rejection of base claim 1 is incorporated. further discloses *wherein the rule includes at least one of number of dimensions, data sparsity, and a value of data as rule criteria*. Since claim 11 recites limitations in a form of alternative expression and explicitly claims at least one of the recited limitations, the Office considers only the limitation *data sparsity* for art rejection purposes. The limitation *data sparsity* is considered taught by Yaginuma (see at least Figure 39, e.g., "dispersion value" and related discussion in the specification).

Claim 16

Rejection of base claim 13 is incorporated. Yaginuma further discloses *wherein the database further stores at least one trigger* (see at least Figure 4, steps S11, S12 and related discussion in the specification).

Claim 17

‑ Rejection of base claim 13 is incorporated. Yaginuma further discloses *wherein the database further stores at least one threshold value and wherein the graph generator selectively applies at least one rule and graph type to the data set to generate at least one graph as a result of a threshold value being met or exceeded* (see at least Figure 39 and related discussion in the specification).

Claim Rejections – 35 USC § 103

14.   The following is a quotation of the 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15.   Claims 5, 6 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

U.S. Patent No. 6,477,538 to Yaginuma et al. ("Yaginuma"), as applied to the base and intervening claims.

Claims 5 and 21

Yaginuma does not specifically disclose *wherein the publishing step includes publishing a graph to a web site.* However, official notice is taken that publishing a graph or an image to a web site is well known in the art (see Lemay's *Teach yourself Web Publishing with HTML 3.0 in a week*, Chapter 9, 2nd Edition, 1996, SAMS.net). The basic requirement is that the graph filename is to be saved with the .gif extension. In order to publish the graph to web page, the following tag can be used: <IMG SRC = "../image.gif>.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the above HTML tag to publish graphs in Yaginuma to a web site so that the graph can be viewed on the WWW.

Claims 6 and 21

Yaginuma does not specifically disclose *wherein the publishing step includes publishing a graph by transmitting the graph in connection with email.* However, official notice is taken that it is well known in that art to attach a graph or image file to an e-mail message so that this graph or image file can be transmitted to an e-mail recipient. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use attach graph files in Yaginuma to an e-mail message so that the graph file can be sent to an e-mail recipient.

Conclusion

16.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone

number is (571) 272-3701. The Examiner can normally be reached on Tuesday-Friday, 6:00 to 16:15.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam can be reached at (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit 2122

October 26, 2004

ANTONY NGUYEN-BA
PRIMARY EXAMINER